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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,454	11/20/2001	Thomas Wirycz	7189	2430

29602 7590 09/09/2005

JOHNS MANVILLE INTERNATIONAL, INC.  
717 SEVENTEENTH STREET  
DENVER, CO 80202

EXAMINER

PIERCE, JEREMY R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Supplemental  
Office Action Summary

Application No.

09/996,454

Applicant(s)

WIRYCZ ET AL.

Examiner

Jeremy R. Pierce

Art Unit

1771

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-20, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-20, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's after final amendment filed on May 10, 2005 has been entered. The Examiner's amendment made on June 2, 2005 also remains entered. Claims 1-3, 5-20, 23, and 24 are currently pending. Applicant's amendment and arguments are sufficient to withdraw the 35 USC 103 rejections set forth in sections 3 and 5 of the Final Rejection dated March 9, 2005. The prior art reference of Draxo et al. (U.S. Patent No. 6,337,104) have been shown by Applicant to be disqualified under 35 U.S.C. 103(c) as prior art. The combination of Jackson (U.S. Patent No. 5,876,551) and Melber (U.S. Patent No. 4,902,722) do not disclose or suggest impregnating the glass fabric using a water based chemical dispersion comprising starch and a polymeric binder. Jackson teaches various plastisols that are used to treat the glass fiber substrate (column 4, line 62 – column 5, line 25). However, using a water-based dispersion comprising starch and polymeric binder is not an obvious variant of these.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on May 10, 2005 disclaiming the terminal portion of any patent granted on this Application which would extend beyond the expiration date of prior Patent Nos. 6,291,011 and 6,337,104 has been reviewed and is accepted. The terminal disclaimer has been recorded. The Double Patenting rejections set forth in sections 7 and 8 of the Final Rejection dated March 9, 2005 are withdrawn.

***Withdrawal of Allowance***

3. The Examiner allowed claims 1-3, 5-20, 23, and 24 on June 2, 2005. This allowance is withdrawn because the 35 USC 103 rejection set forth in section 4 of the Final Rejection dated March 9, 2005 is not overcome with Applicant's arguments filed on May 10, 2005.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being obvious over Edlund (U.S. Patent No. 6,291,011) in view of Melber (U.S. Patent No. 4,902,722).

The Edlund reference qualifies as prior art under 102(a), so 103(c) cannot be invoked relative to Edlund because 103(c) only applies to prior art under sections 102(e), 102(f), and 102(g). Also note that any declaration that might swear behind the Edlund reference to overcome the rejection must also swear behind EP 1,101,749 to Edlund because the EP '749 Patent also qualifies as prior art under 102(a) and it contains the same disclosure as the US '011 Patent.

Edlund discloses a method of producing a fiberglass wallcovering similar to the present invention (claim 1). Edlund does not teach applying a second image coating of expandable material. Melber teaches a syntactic foam material that can be applied to any suitable medium to provide graphic representations (column 2, lines 38-48), including wallcovers and fiberglass (column 7, lines 16-30). The foam of Melber comprises polymeric binder and expandable microspheres (column 3, lines 9-65). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use the image coating step of Melber in addition to the processing steps of Edlund in order to provide a graphic representation to the wallcovering, as taught by Melber. With regard to claims 2, 3, and 5-15, see the dependent claims of the Edlund reference. With regard to claim 16, Melber discloses using acrylic latex binder (Example I). With regard to claims 17 and 18, Melber discloses adding various modifiers to the material (column 3, lines 24-28). Additionally, Melber discloses the foam must be stable (column 1, lines 33-37). It would have been obvious to a person having ordinary skill in the art at the time of the invention to add defoaming agent in order to better stabilize the expandable material, as desired by Melber. With regard to claim 19, Melber discloses the foam material includes pigment (column 3, lines 11-12). With regard to claim 20, Melber discloses using several different printing methods (column 6, lines 55-57). With regard to claims 23 and 24, Melber teaches the expansion takes place upon the application of heat (column 5, lines 1-5).

***Response to Arguments***

6. Applicant's arguments filed May 10, 2005 have been fully considered but they are not persuasive.

7. Applicant asserts that Edlund is disqualified as prior art under 35 USC 103(c) by stating that the reference and the instant application were commonly owned at the time the invention was made. However, 103(c) states that prior art can only be excluded in a 103 rejection when it qualifies only under subsections (e), (f), and (g) of section 102. Here, Edlund (US '011) also qualifies as prior art under 35 USC 102(a) because it was patented on September 18, 2001, which is more than 2 months before the filing date of the present application. Therefore, the rejection is maintained. Also note that the Edlund (EP '749) reference is similarly qualified under 102(a).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

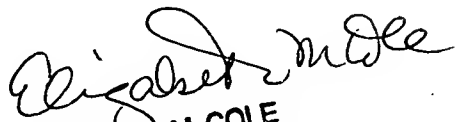
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on normal business hours, but works flextime hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeremy R. Pierce  
September 6, 2005

  
ELIZABETH M. COLE  
PRIMARY EXAMINER